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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,219	03/30/2004	Tatsuhito Mutoh	O11.2-11521-US01	3864

490 7590 04/26/2006

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER	
MARCHESCHI, MICHAEL A	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/813,219	MUTOH ET AL.	
	Examiner	Art Unit	
	Michael A. Marcheschi	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,20 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18,20 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for synthetic resin, does not reasonably provide enablement for resin, in general. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The claims recite resin product. This encompasses any resin product, either synthetic or natural. However, the specification only teaches synthetic resin products. Such a limited disclosure does not support the breadth of the instant claims.

Claims 1, 2, 6-10, 13-14 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,371,555 for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claim 21 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,371,555.

The reference teaches that metal disks can be polished, thus anticipating the claim. With respect to the 103 rejection, since this is dependent on claim 20, the obviousness reasons defined for claim 20 are hereby incorporated herein by reference.

Claims 5, 11, 12, 16-17 are rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 in view Shemo et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 15 is rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 in view Ide et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 18 is rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 in view Shemo et al. and/or Miyata for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-4 and 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Orii et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claim 21 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Orii et al.

The reference teaches that metals (column 10, lines 1-15) disks can be polished, thus anticipating the claim. With respect to the 103 rejection, since this is dependent on claim 20, the obviousness reasons defined for claim 20 are hereby incorporated herein by reference.

Claims 5-8, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as obvious over Orii et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 18 is rejected under 35 U.S.C. 103(a) as obvious over Orii et al. in view Shemo et al. and/or Miyata for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 4/19/06 have been fully considered but they are not persuasive.

Applicants argue that the GB reference does not teach a reaction product formed from the claimed materials. Applicants appear to be relying on process limitations (how the product is formed (i.e. by **reaction** between the specified components) and as is well established, process limitations used to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, it is the examiners position that either (1) the copolymer or (2) the alkyl ether reads on the material used, irrespective of how it was made or the reaction used to produce it. Applicants have not shown otherwise. Applicants admit the reaction of the claimed materials is a polyoxyethylene polyoxypropylene alkyl ether, however, the arguments are based on the

number of carbon atoms in the alkyl group. The claim does not define any carbon atoms in the alkyl group, thus applicants are arguing limitations not claimed (the features upon which applicant relies are not recited in the rejected claims). In addition, applicants provide **no** clear evidence that the claimed **final** material is distinct from the material used in the prior art. A mere statement without supporting facts is insufficient to establish patentability. Finally, the reference reaction product, as can be seen the description on page 10, line 1-page 11, line 27, is a reaction of polyalkylene oxide (oxides alone or copolymers thereof) and ethylene glycol. Column 10, lines 25-26 states that mixtures of the recited copolymers.

Applicant only argument based on Orii et al. is that this reference does not teach a metal salt. The examiner disagrees because column 5, lines 59+ teaches an acid salt (metal salt of an acid). With respect to the claimed combination, this acid salt is added with a polymeric compound (see column 5, lines 5-6) and it is the examiners position that one skilled in the art would have appreciated that the polymeric compounds includes the polyols of the reference, thus the reference, as a whole, reads on the claimed combination.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. ***In re Opprecht*** **12 USPQ 2d 1235, 1236 (CAFC 1989);** ***In re Bode*** **USPQ 12;** ***In re Lamberti*** **192 USPQ 278;** ***In re Bozek*** **163 USPQ 545, 549 (CCPA 1969);** ***In re Van Mater*** **144 USPQ 421;** ***In re Jacoby*** **135 USPQ 317;** ***In re LeGrice*** **133 USPQ 365;** ***In re Preda*** **159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See** ***In re Van Marter*****, 144 USPQ 421.**

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see ***In re Malagari*****, 182 U.S.P.Q. 549;** ***In re Wertheim*** **191 USPQ 90 (CCPA 1976).**

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-12331233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/05
MM

Michael A Marcheschi
Primary Examiner
Art Unit 1755